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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/146,069

Applicant(s)

YOSHIDA, TAKEHIRO

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/1/02 has been entered.

Response to Amendment

2. Applicant's amendments received on 1/31/02 and 4/1/02 have been entered and made of record. Currently, *claims 1-25* are pending.

Claim Objections

3. **Claims 2 and 10** are objected to because of the following informalities:

In line 7 of both *claims 2 and 10*, the acronym of "POP" has two possible meanings known within the art, with the first being "Post Office Protocol", and the second being "Point Of Presence". While the specification does state on page 32, line 11, that the term POP is referring to Post Office Protocol, the claims, as currently written, are unclear of this. The examiner suggests amending line 7 of both claims to read "POP (Post Office Protocol)."

Appropriate correction is required.

see page 2 lines 15-16.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1 and 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 8/1/01).

Regarding **claims 1 and 9**, Williams discloses a communication apparatus (fax call-back device 53, seen in Figs. 9-11) and method (see Fig. 12) comprising a means for performing facsimile communication through the Internet (see Fig. 11) by dial-up connection (see abstract, and column 9, lines 10 through 29), and means for notifying a recipient (fax call-back device 54) using a PSTN (see step 82 in Fig. 12) that a facsimile is being sent through the Internet (column 8, line 61 through column 9, line 9), prior to the recipient (fax call-back device 54) accessing the Internet (column 9, lines 4 through 20).

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6. **Claims 20-25** are rejected under 35 U.S.C. 102(e) as being anticipated by Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 8/1/01).

Regarding **claim 20**, Mordowitz discloses a communication apparatus (ITA 10) comprising means for transmitting facsimile data via the Internet (see abstract, and column 4, lines 10 through 20, and column 5, lines 45 through 55), and means (step 98 in Fig. 4, column 4, lines 21 through 36) for notifying a recipient, by a method different from that of the transmission means (POTS call, "no" in step 96), that the transmission means has executed transmission of the facsimile data via the Internet (step 94 in Fig. 4, column 4, lines 10 through 20, wherein the transmission of the facsimile data via the Internet was executed, but could not be completed since the remote modem was not logged onto the Internet).

Regarding **claim 21**, Mordowitz discloses the apparatus discussed above in claim 20, and further teaches that the transmission means transmits the data through the Internet (see Fig. 1), and the notification means transmits notification through a public telephone network (conventional long distance telephone lines 12 via public exchange switches 15, seen in Fig. 1).

Regarding **claim 22**, Mordowitz discloses a communication apparatus (ITA 10) comprising first means (Internet connect processing 64 software, and Internet communication protocol 68 software, seen in Fig. 3) for sending facsimile data over a first communication network (Internet, see Fig. 1) to a recipient (see abstract, and column 4, lines 10 through 20, and column 5, lines 45 through 55), second means (Internet call setup 76 software, seen in Fig. 3) for sending data over a second communication network (long distance telephone network, seen in Fig. 1) to the recipient (column 4, lines 27 through 36), and third means (master program 60, seen in Fig. 3) for controlling the first means and the second means (column 3, line 65 through

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column 4, line 9), wherein the third means controls the second means so as to send data (step 98 in Fig. 4, column 4, lines 21 through 36) corresponding to sending operation of the first means (see Fig. 4), and wherein the sending operation of the second means indicates that the first means has executed transmission of the facsimile data over the first communication network to the recipient (step 94 in Fig. 4, column 4, lines 10 through 20, wherein the transmission of the facsimile data via the Internet was executed, but could not be completed since the remote modem was not logged onto the Internet).

Regarding *claim 23*, Mordowitz discloses the apparatus discussed above in claim 22, and further teaches that the first communication network (Internet) is a facsimile communication network (see abstract).

Regarding *claim 24*, Mordowitz discloses the apparatus discussed above in claim 22, and further teaches that the second communication network is a telephone network (conventional long distance telephone lines 12 via public exchange switches 15, seen in Fig. 1).

Regarding *claim 25*, Mordowitz discloses the apparatus discussed above in claim 22, and further teaches that the data sent by the second means is a part of data sent by the first means (column 4, lines 27 through 31).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 2 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 8/1/01) in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 8/1/01).

Regarding **claims 2 and 10**, Mordowitz discloses a communication apparatus (ITA 10) and a control method for the communication apparatus (see Fig. 4) comprising a means for performing facsimile communication through the Internet by dial-up connection (see abstract, and column 4, lines 10 through 20, and column 5, lines 45 through 55), and means for, when it is notified by a calling party communication apparatus using a telephone line (step 98 in Fig. 4, using POTS line, column 4, lines 22 through 34) that communication through the Internet has been executed by dial-up connection (step 94 in Fig. 4, column 4, lines 17 through 21, wherein a communication through the Internet was executed), setting up connection to the Internet by dial-up connection (step 100 in Fig. 4) and receiving facsimile communication information through the Internet (see abstract).

However, Mordowitz fails to specifically teach of in notifying **using a PSTN** by a calling party communication apparatus that communication through the Internet has been executed by dial-up connection, and of receiving facsimile communication information through the Internet

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by POP. Kulakowski discloses a communication apparatus (see Figs. 1 through 3, interface apparatus 26) and a control method for the communication apparatus (see Fig. 5) comprising a means for performing facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), and means for, when it is notified by a calling party communication apparatus (network service provider 32, wherein the provider 32 calls the receiving interface device 26) using a PSTN (telephone connection 30, being a PSTN, page 8, lines 3 through 23) that communication through the Internet has been executed by dial-up connection (page 20, lines 24 through 28), receiving facsimile communication information through the Internet by POP (page 2, lines 8 through 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Mordowitz's system. Mordowitz's system would easily be modified to include Kulakowski's teachings, therein conforming with well known standards commonly used throughout the art, as recognized by Kulakowski.

9. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 8/1/01) in view of Cooper *et al.* (U.S. Patent Number 6,052,442, cited in the Office action dated 8/1/01).

Regarding **claim 3**, Williams discloses the system discussed above in claim 1, but fails to specifically teach of a means for selecting on the basis of a user operation whether the communication is an important communication, and wherein when the important communication is not selected, the notification means do not notify using a PSTN that the facsimile is being sent through the Internet. Cooper discloses a communication apparatus (Internet answering machine,

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seen in Fig. 1) comprising a means for performing facsimile communication through the Internet (column 6, lines 38 through 57) by dial-up connection (see Fig. 5), and means for notifying a recipient (see Fig. 2-2) using a telephone network (column 7, lines 4 through 10) that a facsimile is being sent through the Internet (column 7, lines 4 through 14), prior to the recipient accessing the Internet (seen in Fig. 5, which corresponds to step 66 in Fig. 2-1). Further, Cooper teaches of a means for selecting on the basis for a user operation whether the communication is an important communication (column 6, lines 16 through 29, and column 7, lines 2 through 14), and wherein when the important communication is not selected, the notification means do not notify that the facsimile is being sent through the Internet (column 6, line 66 through column 7, line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Cooper's teachings in Williams' system, therein including a means for selecting on the basis for a user operation whether the communication is an important communication, and wherein when the important communication is not selected, notification means do not notify the station using a PSTN that the facsimile communication through the Internet has been executed. The system of Williams would become more efficient with the addition of Cooper's teachings, as notifications would only be sent when priority is designated, therein not tying up the system with unnecessary communications over the telephone network.

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10. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 8/1/01) in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 8/1/01), and further in view of Cooper *et al.* (U.S. Patent Number 6,052,442, cited in the Office action dated 8/1/01).

Regarding **claim 4**, Mordowitz and Kulakowski disclose the apparatus discussed above in claim 2, but fail to particularly teach of a means for registering a time of execution of POP processing on the basis of a user operation. Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and a control method for the communication apparatus comprising a means for performing facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), and means for, in response to a notification (column 6, lines 16 through 29, and column 7, lines 2 through 14), from a calling party communication apparatus (service provider central computer, column 1, lines 41 through 48, which is calling the communication apparatus, column 2, lines 57 through column 3, line 4, and steps 46 and 54 in Fig. 2-1) using a telephone line (5, column 4, lines 30 through 47) that the calling party communication apparatus is sending a facsimile to the communication apparatus (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), setting up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) and receiving facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64). Cooper further teaches of a means for registering a time of execution of POP processing on the basis of a user operation (step 70 in Fig. 3, column 8, lines 14 through 20), and wherein the reception means set up connection to the

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Internet at the registered time and receive the facsimile communication information through the Internet by POP ("yes" branch of step 72, leading to steps 74, 76, and 80, column 8, lines 20 through 38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Cooper's teachings in the system of Mordowitz and Kulakowski. Mordowitz and Kulakowski's system would become more user-friendly with the addition of Cooper's teachings, as the users would be able to select when to connect to the Internet to receive facsimile messages, as recognized by Cooper.

11. **Claims 5-8, and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper *et al.* (U.S. Patent Number 6,052,442, cited in the Office action dated 8/1/01) in view of Ho *et al.* (U.S. Patent Number 5,805,298, cited in the Office action dated 8/1/01).

Regarding **claims 5 and 11**, Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and control method capable of facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), comprising a means (display of pager) for, in response to a notification (being steps 55 and 57, having the paging option selected), from a calling party communication apparatus (service provider central computer, column 1, lines 41 through 48, which is calling the communication apparatus, column 2, lines 57 through column 3, line 4, and steps 46 and 54 in Fig. 2-1) using a telephone call (column 7, lines 4 through 10, through the pager of step 55) that the calling party communication apparatus (service provider) is sending a facsimile to the communication apparatus (column 7, lines 1 through 14, wherein an indication that a message has been received at the service

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provider, and a portion of the e-mail message is being sent to the Internet answering machine, as seen in step 54, column 6, lines 50 through 65, and column 10, lines 25 through 39), displaying information representing that the calling party communication apparatus (service provider) is sending a facsimile to the communication apparatus (column 7, lines 7 through 14) and station address information of a calling party (column 7, lines 10 through 14, wherein the header of each e-mail message inherently includes address information of a calling party), means for determining on the basis of selection by a user whether the communication apparatus is to set up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) to receive facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

However, Cooper fails to particularly teach if a notification, from a calling party communication apparatus uses *a PSTN*, and if the calling party communication apparatus (service provider central computer) sends the facsimile to the communication apparatus (Internet answering machine) *through the Internet*, as the service provider is connected to the Internet answering machine by telephone line 5, as read in column 5, lines 40 through 63. Ho discloses a communication apparatus (communications device 100) capable of facsimile communication through the Internet (see Figs. 1 and 3) by dial-up connection (column 3, line 53 through column 4, line 6) comprising a means (display 208) for, in response to a notification (step 416 in Fig. 4, and column 8, lines 18 through 26), from a calling party communication apparatus (remote mail server 110 or 111, seen in Fig. 1) using *a PSTN* (106, seen in Fig. 1) that the calling party communication apparatus (remote mail server) is sending a facsimile to the communication apparatus *through the Internet* (Internet 112, seen in Figs. 1 and 4, and column 8, lines 26

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through 67, wherein the sending of the facsimile message occurs in step 418), displaying information representing that the calling party communication apparatus (remote mail server) is sending a facsimile to the communication apparatus *through the Internet* (Internet 112, seen in Figs. 1 and 4, and column 8, lines 26 through 67, wherein the sending of the facsimile message occurs in step 418) and station address information of a calling party (column 8, lines 29 through 37). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Ho's teachings in the system of Cooper. Cooper made the design choice of having the answering machine connected to the service provider through a telephone line, but would easily have been modified to be connected through the Internet, and a telephone line through the PSTN, as recognized by Ho.

Regarding *claim 6*, Cooper and Ho disclose the apparatus discussed above in claim 5, and Cooper further teaches of a means for registering whether, in response to the notification (steps 55-59 in Fig. 2-2), dial-up connection is to be immediately performed on the basis of the station address of the calling party communication apparatus (column 9, lines 40 through 49, and column 5, lines 54 through 66, step 46 in Fig. 2-1) to receive the facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

Regarding *claim 7*, Cooper and Ho disclose the apparatus discussed above in claim 5, and Cooper further teaches that when dial-up connection is performed to receive the facsimile communication information through the Internet (step 94 of Fig. 5), all pieces of facsimile communication information received by a service provider are received (column 10, lines 40 through 64).

Regarding **claim 8**, Cooper and Ho disclose the apparatus discussed above in claim 5, and Cooper further teaches of display means (display 16) for, in response to the notification (steps 55-59 in Fig. 2-2), displaying a list of communication management information independently of communication management information associated with normal transmission/reception (see Fig. 4, column 9, lines 7 through column 10, line 15), and displaying whether reception of the facsimile communication information from the service provider is complete (column 10, line 65 through column 11, line 14).

12. **Claims 12, 13, 18, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 8/1/01) in view of Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 8/1/01), and further in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 8/1/01).

Regarding **claims 12 and 18**, Mordowitz discloses a communication apparatus (first ITA 10), with a control method, capable of facsimile communication through the Internet (90, see Fig. 1, and abstract) by dial-up connection (column 4, lines 10 through 20), comprising means for performing dial-up connection from a station A (calling telephone 16) to an Internet service provider (ISP 11) to execute communication with a station B (second ITA 20, see Figs. 1 and 4, steps 82 through 92) **having an e-mail address** through the Internet (see Fig. 1), and means for calling the station B from the station A, when the dial-up connection is established, notifying the station B **via a telephone line** (POTS, see Figs. 1 and 4) that facsimile communication is being sent through the Internet and description information of the facsimile communication executed

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through the Internet (step 98 in Fig. 4, column 4, lines 21 through 36), prior to station B accessing the Internet (step 100 in Fig. 4, column 4, line 22 through 36).

However, Mordowitz fails to specifically teach of notifying the station B *via the PSTN*. Williams discloses a communication apparatus (fax call-back device 53, seen in Figs. 9-11), with a control method (see Fig. 12), capable of facsimile communication through the Internet (see Figs. 9-11) by dial-up connection (see steps 77 through 80 in Fig. 12), comprising means for performing dial-up connection from a station A (fax call back device 53) to an Internet service provider (ISP 57) to execute communication with a station B (fax call back device 54) through the Internet (see Fig. 11), and means for calling the station B from the station A, notifying the station B via the PSTN (see step 82 in Fig. 12) that facsimile communication is being sent through the Internet (column 8, line 61 through column 9, line 9), prior to the station B (fax call-back device 54) accessing the Internet (column 9, lines 4 through 20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Williams in the system of Mordowitz. Mordowitz's system would easily be modified with Williams' teachings, as the systems share cumulative features, being additive in nature, therein conforming to well known standards of having a PSTN be a standard telephone network.

Continuing, Mordowitz and Williams do not specifically teach if station B has a TCP/IP address, as the station has an e-mail address. Bloomfield discloses a communication apparatus (fax interface device 102) capable of facsimile communication through the Internet (email network 116), comprising means for performing dial-up connection from a station A (fax device 106) to an Internet service provider (e-mail server 112) to execute communication with a station

Public
Switch
15 is
PSTN
?

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B (e-mail device 118) *having a TCP/IP address* through the Internet (column 7, lines 35 through 53). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Mordowitz and Williams's system. Mordowitz and Williams's system would easily be implemented with Bloomfield's teachings, as an e-mail address is well known within the art to be a TCP/IP address, as recognized by Bloomfield, thereby conforming to industry standards.

Regarding *claim 13*, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, and Mordowitz further teaches that the description information is summarized text representing a summary of facsimile communication (column 6, lines 11 through 24, wherein the intended telephone number is summarized text).

Regarding *claim 19*, Mordowitz discloses a computer readable storage medium (ROM 28, column 3, lines 26 through 31) which stores a program (program 60, seen in Fig. 3, column 3, line 65 through column 4, line 9) for controlling a communication apparatus (first ITA 10), with a control method, capable of facsimile communication through the Internet (90, see Fig. 1, and abstract) by dial-up connection (column 4, lines 10 through 20), comprising code for establishing a dial-up connection from a station A (calling telephone 16) to an Internet service provider (ISP 11) to execute communication with a station B (second ITA 20, see Figs. 1 and 4, steps 82 through 92) *having an e-mail address* through the Internet (see Fig. 1), and code for calling the station B from the station A, when the dial-up connection is established, notifying the station B *via a telephone line* (POTS, see Figs. 1 and 4) that facsimile communication is being sent through the Internet and description information of the facsimile communication executed

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through the Internet (step 98 in Fig. 4, column 4, lines 21 through 36), prior to the station B accessing the Internet (step 100 in Fig. 4, column 4, line 22 through 36).

However, Mordowitz fails to specifically teach of notifying the station B *via the PSTN*. Williams discloses a communication apparatus (fax call-back device 53, seen in Figs. 9-11), with a control method (see Fig. 12), capable of facsimile communication through the Internet (see Figs. 9-11) by dial-up connection (see steps 77 through 80 in Fig. 12), comprising means for performing dial-up connection from a station A (fax call back device 53) to an Internet service provider (ISP 57) to execute communication with a station B (fax call back device 54) through the Internet (see Fig. 11), and means for calling the station B from the station A, notifying the station B via the PSTN (see step 82 in Fig. 12) that facsimile communication is being sent through the Internet (column 8, line 61 through column 9, line 9), prior to the station B (fax call-back device 54) accessing the Internet (column 9, lines 4 through 20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Williams in the system of Mordowitz. Mordowitz's system would easily be modified with Williams' teachings, as the systems share cumulative features, being additive in nature, therein conforming to well known standards of having a PSTN be a standard telephone network.

Continuing, Mordowitz and Williams do not specifically teach if station B has a TCP/IP address, as the station has an e-mail address. Bloomfield discloses a communication apparatus (fax interface device 102) capable of facsimile communication through the Internet (email network 116), comprising means for performing dial-up connection from a station A (fax device 106) to an Internet service provider (e-mail server 112) to execute communication with a station

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B (e-mail device 118) *having a TCP/IP address* through the Internet (column 7, lines 35 through 53). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Mordowitz and Williams's system. Mordowitz and Williams's system would easily be implemented with Bloomfield's teachings, as an e-mail address is well known within the art to be a TCP/IP address, as recognized by Bloomfield, thereby conforming to industry standards.

13. **Claims 14 through 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 8/1/01) in view of Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 8/1/01), further in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 8/1/01), and further in view of Bobo, II (U.S. Patent Number 5,675,507, cited in the Office action dated 8/1/01).

Regarding **claim 14**, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach if the description information is information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing

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that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37).

Further, Bobo teaches that the description information is information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message.

Regarding *claim 15*, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach of transmitting a number of pages of facsimile information transmitted through the Internet and a communication time. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the notification means further transmits the number of pages of facsimile information transmitted through the Internet (column 8, lines 53 through 60) and a communication time (column 8, lines 53 through 60). Therefore, it would have been obvious to a

person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options based on the number of pages of transmitted facsimile messages, and the communication time, without downloading the entire message.

Regarding *claim 16*, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, but fail to specifically teach of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication or information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches of a means for selecting, as the description information to be transmitted, either summarized text representing a summary of facsimile communication (column 8, lines 53 through 63) or information of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was

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made to include Bobo's teachings in Mordowitz's system. Mordowitz's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options, without downloading the entire message.

14. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Mordowitz *et al.* (U.S. Patent Number 6,011,794, cited in the Office action dated 8/1/01) in view of Williams *et al.* (U.S. Patent Number 6,192,045, cited in the Office action dated 8/1/01), further in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 8/1/01), and further in view of Wegner *et al.* (U.S. Patent Number 5,712,907, cited in the Office action dated 8/1/01).

Regarding **claim 17**, Mordowitz, Williams, and Bloomfield disclose the apparatus discussed above in claim 12, and Mordowitz further teaches of a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means (see Fig. 4, "no" branch of step 84, leading to steps 86 and 88, column 4, lines 21 through 35). However, Mordowitz, Williams, and Bloomfield fail to teach of transmitting the facsimile information through the general public network when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Wegner discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (column 4, lines 7 through 11), comprising means for performing dial-up connection from a station A (message communicating device 2s) to an Internet service provider (network node 6s) to execute communication with a station B (message communicating devices 1r, 2r, or 3r) having a TCP/IP address through the

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Internet (column 8, lines 31 and 32, and column 13, line 64 through column 14, line 3), and means for, when communication by the Internet communication execution means has been executed, calling the station B (recipient 8r in Fig. 7a) using a general public network (PSTN 5) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (column 3, lines 52 and 53). Further, Wegner teaches of a means (least cost routing processor 103) for, when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value (column 10, lines 21 through 23, and column 12, lines 59 through 62, wherein the number of pages of the message corresponds to the size of the message), transmitting the facsimile information from the station A to the station B through the general public network (PSTN 5) without performing communication by the Internet communication execution means (column 3, lines 54 65, and column 7, lines 25 through 62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Wegner's teachings in Mordowitz's system, thereby having a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Mordowitz's system would become more efficient if adapted to incorporate Wegner's teachings, as the most cost effective transmission would be selected to route the facsimile message.

Citation of Pertinent Prior Art

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Creamer *et al.* (U.S. Patent Number 6,278,704) discloses a system that allows a telephone line connected to the Internet to receive extended telephone services through that line without interrupting the connection to the Internet;

Vazana (U.S. Patent Number 5,850,519) discloses an electronic mail notification system.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

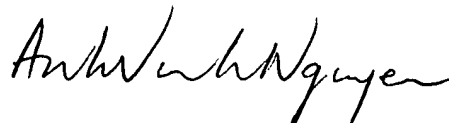
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
June 6, 2002



MADELEINE NGUYEN
PATENT EXAMINER

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